

Appl. No.: 10/821,426
Amdt. dated: October 5, 2006
Reply to the Office action mailed: July 31, 2006

Remarks and Arguments

Certain paragraphs on pages 5 and 7 of the specification have been amended. Having amended claims 5 and 8, the claims presently active in this application are claims 1 thru 15. Reconsideration is respectfully requested.

The Examiner has rejected claims 5 - 7 under 35 U.S.C. 112, second paragraph as being indefinite for particularly point out and distinctly claim the subject matter which Applicant's regards as the invention. This rejection is respectfully traversed.

In explanation of the above rejection under 35 U.S.C. 112, second paragraph, the Examiner notes that the ratio of solvent to probucol is recited as a ratio, but, the units assigned to the values in said ratio are unclear. The Examiner illustrates the units of possible ratios as "Wt: Vol, Wt: Wt. Moles: Moles".

The term "ratio", which is also defined as "proportional" is one that enjoys substantial use in both patent and non-patent publications. See Webster's New Collegiate dictionary. Concerning the definition of these words "ratio" and "proportional", the case *Relume Corp. v. Dialight Corp et al.*, 63 F. Supp. 2d, 788 (C.E.D. Mich., 1999) is instructive. In discussing the claims in dispute in that case, the court said

"...in Webster's the relevant definition of "proportional" is "having the same or a constant ratio".... The key to understanding its scope is the meaning of "ratio". Webster's defines it as "the fixed or approximate relationship of one thing to another". At 804, Section 1, 2d full paragraph.

Thus, "ratio" is a dimensionless parameter and can be applied to an almost limitless variety of situations. For example, in *Hooker Electrochemical Co. v. Watson*, (DC Appl. No.: Appl

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1954) 135 F. Supp. 275, the court notes that the patent "... teaches the solvent-extraction of the gamma isomer from crude benzene but expressly limits the amount of solvent used to a ratio of 1 part of solvent or less per part of crude. ..." at 277. .

With the above Webster's definition in mind, and *Hooker Electrochemical* as an example, a ratio of solvent to probucol derivative of 5:1 means simply that 5 times (parts) as much solvent is used per part of probucol derivative.

Applicant's do not believe that one skilled in the art, having Applicant's specification as a guide, would have any difficulty in understanding how to use the ratios disclosed there.

However, in order to advance the prosecution of the instant application and to accommodate the Examiner, Applicant's have amended the specification and claims to clarify the units that the ratios may represent. Thus, amendments to the specification on page 5 and claims 5 thru 7 make it very clear that the ratios are by weight. Although the exact phrase is not in the application, the Examples show that Applicant's invention can be illustrated by experiments where a solvent and probucol derivative are measured into the reaction vessel in weight percent and in grams, i.e., by weight. See the specification, the Examples, Example 1 where 1 equivalent of probucol is admixed with 60 weight percent of acetone and Example 6, where 500 grams of probucol and 300 grams of acetone are combined. These quantities are, of course, measured by weight with a probucol derivative to solvent ratio of 2:3 and 5:3 respectively

Because of the above-noted amendments, it is believed that the rejection of claims 5 - 7 under 35 U.S.C. 112, second paragraph as being indefinite for particularly point out and distinctly claim the subject matter which Applicant's regards as the invention should be

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withdrawn.

The Examiner has rejected claims 11-15 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner explains that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, in the claims in question, the pH of the mixture formed in step 2 of the claimed process is reduced to less than 7. However, the pH of the reaction mixture in the second step of the process is mentioned on page 8 of the specification, but no method of reducing the pH and no values to which the pH is to be reduced to are in the specification. This rejection is respectfully traversed.

Applicant's have amended the specification, specifically page 8, last full paragraph by replacing the original, as filed, paragraph with one that now contains then disclosure desired by the Examiner. This, the amended paragraph now repeats what was particularly recited in the claim 11, i.e., that the "... reaction mixture of the compounds of Formula 2 is acidified in the presence of the same or a different organic hydrocarbon solvent that was previously used to remove the unreacted probucol or probucol derivative. In this way, the pH of such reaction mixture formed in reaction step (2) is reduced to less than 7...".

It is believed that the above amendment to the specification obviates the above rejection under 35 U.S.C. 112, first paragraph.

The Examiner has rejected claims 1 - 4 and 8 - 10 under 35 U.S.C. 103 (a) as being unpatentable over Jass (U.S. Pat. No. 6,323,359, in view of Wang (U.S. Pat. No. 3,485,843. This rejection is respectfully traversed.

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Applicant's have attached to this Response, an Appendix including copies of the following documents:

Assignment of all right, title and interest to the instant patent application "PROCESS FOR THE PREPARATION OF PROBUCOL DERIVATIVES" from the inventors Paul Alan Jass and Jason Scott Douglas to Cambrex Charles City, Inc. The assignment is dated April 7, 2004 and properly notarized.

Recordation Form Cover Sheet - Patents Only showing the mailing of the above noted Assignment to the Director of the U.S. Patent and Trademark Office and the request for recording of such Assignment.

Acknowledgement of Document Filed by the Iowa Secretary of State whereby receipt of Articles of Amendment is acknowledged.

Certificate of Amendment of the Articles of Incorporation of Salsbury Chemicals, Inc. whereby a resolution is adopted amending the Articles of Incorporation to change the name of the corporation to Cambrex Charles City, Inc., effective October 5, 2006 1, 2002. The resolution was approved by the Board of Directors of Salsbury Chemicals, Inc. on September 5, 2002.

Statement of Common Ownership of Patent Application No. 10/821,426 and Jass et al, Patent Number 6,323,359

Referring to the documents included in the Appendix, it is clear that the patent application that is the subject of this Office action has been assigned to Cambrex Charles City, Inc. This company was formerly Salsbury Chemicals, Inc., the assignee of the U.S. Pat. No. 6,323,359 Jass et al. As such, the invention set forth in the claims of the patent application serial number 10/821,426, filed April 9, 2004 and having Cambrex Charles City, Inc. as the owner, and U.S. Pat. No. 6,323,359, filed May 2, 2000 and having Salsbury Chemicals, Inc., now Cambrex

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Charles City, Inc. as the owner were commonly owned at the time the invention in the instant application was made and, according to 35 U.S.C. 103 (c) is disqualified as prior art against the instant application. According to the MPEP 706.02(1)(2), (I)n order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned. Since Applicant's have established that there was common ownership of the instant application and the primary reference, Jass U.S. Pat. No. 6,323,3569, used by the Examiner to reject Applicant's claims under 35 U.S.C. 103(a), such primary reference must be withdrawn as a reference against the application.

The Examiner has applied U.S. Pat. No. 3,485,843 as a secondary reference with the primary reference Jass 6,323,359, against the claims of this application. The only use of this '843 patent is because of its teaching of the preparation of probucol compounds. However, there is no suggestion of a first step reaction with a salt such as used in Applicant's improved process or even any appreciation of the importance of a a ketone over other solvents for such process step as claimed by Applicant's. In any event, the use of this reference depends on Jass in order

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to provide a basis for rejecting the claims of this application - and Jass is no longer applicable. Accordingly, any use of the '843 patent for rejection of Applicant's claims must be withdrawn.

In view of the above amendments, remarks and arguments, it is believed this application is now in condition for allowance. Early notice to that effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard J. Hammond", with a stylized flourish at the end.

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